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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,773	01/21/2004	Terry Durand	C03-0007-000; ATT-187	3533
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EXAMINER				
KEEFE, MICHAEL E				
ART UNIT		PAPER NUMBER		
2454				
MAIL DATE		DELIVERY MODE		
09/17/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/761,773

Applicant(s)

DURAND ET AL.

Examiner

MICHAEL E. KEEFER

Art Unit

2454

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-10,15-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-10,15-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed 6/4/2009.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no structure recited in claim 15 to give structure to the claim, thus it falls outside of the statutory classes of invention and is merely software per se. Regarding claim 25, it appears that this is merely a computer program and is merely software per se. The Examiner recommends amending the preamble to state that when the computer-readable media is executed by hardware it causes those steps to take place.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 3-5, 8-9, 15-22, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann et al. (US 6963839), hereafter Ostermann in view of Issacs.

Regarding **claims 1, 15 and 25**, Ostermann discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for

facilitating communications between the sender and the recipient, (Fig. 4(a), 4(b))
the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message;
and forwarding the emoticon and its link to the sound file to the recipient. (Col. 8,
lines 17-28 disclose linking video and audio to a sender-generated message
containing emoticons. Col. 9 lines 59-61 disclose determining sounds to link with
the message based off of emoticons. It is inherent that the message is forwarded
to the recipient, or else there would be no reason to construct it at all. (Note
recipients 72 and 76 in fig. 4a and 4b)

wherein the linking occurs at the server according to user preferences stored
on the server. (Col. 8, lines 17-28 disclose linking video and audio to a sender-
generated message containing emoticons. Col. 9 lines 59-61 disclose
determining sounds to link with the message based off of emoticons. See Col.
10, lines 49-65 for the storage of user preferences (i.e. language) on the server))

Ostermann discloses all the limitations of claims 1, 15, and 25 except for
determining if the recipient has a file prior to sending the file.

The general concept of allowing a recipient to cache files is well known in the
networking art as taught by Issacs (see Fig. 5, steps 220, 240, and 250 Further, note
the user's ability to override default sounds in [0020].).

It would have been obvious to one of ordinary skill in the art at the time of the
invention to combine Ostermann with the general concept of allowing a recipient to
cache files as taught by Issacs in order to decrease network traffic and message size.

Regarding **claims 3 and 16, as applied to claims 1 and 15**, Isaacs teaches:

making a dynamic association, established by the sender, for that particular message being sent. (Fig. 3 discloses linking particular sounds to particular icons creating specific 'earcons', which are particular messages made by the user dynamically.)

Regarding **claims 4 and 17 as applied to claims 1 and 15**, Isaacs teaches:

automatically generating a link according to the particular emoticon being sent. ([0031] discloses that a sound is automatically chosen based upon the icon chosen by the user for the message.)

Regarding **claims 5 and 18 as applied to claims 1 and 15**, Isaacs teaches:

automatically generating a link according to the combination of the particular emoticon being sent and the particular recipient. ([0021] discloses sending different sounds to different recipients depending upon the particular recipient (i.e. has that recipient received a message from the user within a certain amount of time, if not, link a sound file including the user's personal sound.)

Regarding **claims 20, as applied to claim 15**, Isaacs teaches:

wherein the step of linking is performed by the sender. (Fig. 3)

Regarding **claims 8 and 21, as applied to claims 1 and 15**, Isaacs teaches:

wherein the step of linking comprises attaching the sound file to the message, and wherein the step of forwarding comprises forwarding both the message and the sound file. ([0039] discloses sending a sound file with the message.)

Regarding **claims 9 and 22, as applied to claims 1 and 15**, Isaacs teaches:

creating a pointer to a sound file and attaching the pointer to the message.

([0037] discloses including a unique ID that indicates the sound file with the message.)

Regarding **claim 19 as applied to claim 15**, Ostermann discloses:

The linking is preformed on the server. (Col. 8 lines 17-28 disclose that the linking is done by a server.)

3. Claims 10 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ostermann and Issacs as applied to claims 1 and 15 above, and further in view of Mages et al. (US 6463467), hereafter Mages.

Ostermann and Issacs teach all the limitations of claims 10 and 23 except for forwarding the emoticon and its link as a mime-encoded attachment.

Mages teaches:

forwarding the emoticon and its link to the sound file in the form of an MIME-encoded attachment. (Col. 3, line 5 discloses using MIME encoded attachments.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Ostermann and Issacs with the general concept of MIME-encoding files as taught by Mages in order to decrease network traffic and message size.

Response to Arguments

4. Applicant's arguments filed 6/4/2009 have been fully considered but they are not persuasive.

5. Applicant argues that the combination of Isaacs and Ostermann does not disclose all the limitations of claims 1, 15, and 25. The Examiner disagrees, having pointed out the way in which the new limitations map to the references of record in the above rejections. Further, Applicant argues that Ostermann does not disclose linking of sound files with an emoticon, as well as the same argument made towards Isaacs. The Examiner disagrees with this assertion. As seen in Fig. 7, the user selects emoticons that are put into the message, then the server 'links' these emoticons with sounds (i.e. modifying the voice to match the emoticon).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL E. KEEFER whose telephone number is (571)270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MEK 9/13/2009

/NATHAN FLYNN/

Supervisory Patent Examiner, Art Unit 2454